

REMARKS

In response to the Restriction Requirement, Applicants elect the invention of Group II, claims 19 to 37. Applicants respectfully urge that the Restriction Requirement does not establish that searching all inventions constitute an undue burden to the Patent Office, especially as it relates to the inventions of Groups II and III. Moreover, Applicants urge that the Restriction Requirement is contrary to public policy. Accordingly, Applicants submit that the Restriction Requirement is improper and its modification or withdrawal is requested.

It is believed that no fee is required for the consideration of the paper. If, however a fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account No. 50-0320.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP §803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the Restriction Requirement does not meet the second of these criteria as since the inventions, as identified in the Requirement, are so closely related. As indicated in the Office Action, the inventions of Group I to Group III are all searched in the same class. Applicants urge that while the inventions are distinct, the four inventions are so closely related that one would search all the areas in order to have a complete search. This is especially true for the invention of Groups II and III which are related to a process and a device for transdermal therapy, both of which involve ultrasound. It is urged that these two inventions are

so closely related that one would want to search both inventions to perform a complete search. It is noted that all the groups are searched in the same class.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining four patents is unreasonable in view of the fact that the three groups are so closely related. Further, the public is inconvenienced as they will not know whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent applications.

Accordingly, in view of the foregoing, reconsideration and modification of this restriction requirement are requested and an early action on the merits is earnestly solicited.

Respectfully submitted,

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